



PATENT
Docket No. 001

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Sean Fitzgerald
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF PETITIONS

In the application of:

William Wanker

Serial No.: 09/290,006

Filing Date: April 11, 1999

For: CUSTOMIZABLE ELECTRONIC
COMMERCE SYSTEM AND METHOD

Examiner: Nguyen, T.

Group Art Unit: 2172

PETITION TO REVIVE APPLICATION DUE TO UNAVOIDABLE
ABANDONMENT UNDER 37 C.F.R. §1.137(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicant petitions the Commissioner to revive the above identified application as abandoned due to unavoidable circumstances under 37 C.F.R. §1.137(a). Applicant has set forth the relevant facts below. A check in the amount of \$255.00 is attached, to cover the fee for this petition (\$55.00 under 37 C.F.R. §1.17(l)) along with the petition to extend the response period (initially sent with the prior response, but was never cashed). Also attached is the response to the outstanding Office Action mailed within the statutory time to respond, including the two month extension. A favorable decision on this petition is respectfully requested, along with a review of Applicant's Response to the outstanding Office Action.

07/14/2003 RNDNAF1 00000062 09290006

01 FC:2452
02 FC:2252

55.00 OP
200.00 OP

Facts Surrounding the Abandonment

In the prosecution of application serial number 09/290,006 the most recent Office Action was mailed on April 24th, 2002 and received by Applicant's counsel at 1404 El Camino Real, #2, Burlingame, CA 94010, the address of record. This Office Action was received in a timely manner. This Office Action was non-final and was the third Office Action on the merits in the present application. The deadline for response within the shortened statutory period was set for July 24th, 2002.

Applicant's Counsel responded to the outstanding Office Action by mailing a Third Office Action Response, attached herewith, by first class mail from U.S. Post Office branch Burlingame Annex Station, 820 Stanton Rd, Burlingame, CA 94010, on September 11, 2002. The envelope containing the Third Office Action Response was addressed to the Assistant Commissioner for Patents, Department of Commerce, Washington, D.C. 20231, the same address used in all prior correspondence concerning this application.

Counsel clearly recalls the mailing on for three reasons. First, it was on the anniversary of the September 11th tragedy. Second, Counsel stopped at the Burlingame Annex Station on the way to San Francisco International Airport (which is located nearby) to catch a flight to London Heathrow as part of a business trip. Third, Counsel has the receipt from the Burlingame Annex Station clearly identifying the date and postage of \$0.60 for a first class mailing to the 20231 zip code.

As counsel moved Counsel's office on or about August 1, 2002, the Third Office Action Response included Counsel's new address and new phone number, which were listed as 1717 Parrott Drive, San Mateo, CA 94402 and 650-430-1717 (the "new address"). Counsel also included a change of address form indicating the new address and phone number. As part of the move, Counsel put in place a U.S. Postal Service Change of Address and Mail forwarding prior to the move, and prior to the mailing on September 11, 2002. Since the move, Counsel as regularly and reliably received mail sent to the old address, which the U.S. Post Office has kindly forwarded to the new address. As recently as June 10th, 2003, Counsel has received mail forwarded from the old address. Additionally, Counsel

also put in place a telephone forwarding message, which Counsel tested on several occasions and which indicated that Counsel's phone number had been changed and provided the caller with the new phone number. Counsel has regularly received calls from August 2002 through January and February 2003 where the caller had obtained Counsel's new phone number by calling Counsel's old phone number and listening to the forwarding message. Counsel also has had a voice mail service with Counsel's new phone number which has worked reliably since the service was set up in August 2003, and Counsel has never received any indication that the service has failed to record or deliver a message.

Counsel's procedures for receiving and recognizing U.S. PTO correspondence are simple and reliable. During the period from January 1, 2003 through March 2003 Counsel was the only person checking the daily mail. Had a Notice been received it would have been recognized for what it was, and immediately opened and a written record would have been created concerning the Notice, as is Counsel's standard practice. Two reasons highlight this. First, the 1717 Parrott Drive Address is Counsel's home address, the only address available to receive mail on the date the Third Office Action Response was mailed. Since that time Counsel has acquired a business mailing address, and all other mailings with the U.S. Patent and Trademark office Occur through that address. Counsel is also the only person receiving and opening mail at the business address (which was not part of the forwarding instructions to the U.S. Post Office and no mail from Counsel's old address has ever been forwarded to the business address), and the Notice of Abandonment has not been received at the business address.

On March 27th, 2002 Counsel called Examiner Nguyen, T inquiring into the status of the present Application. Examiner Nguyen informed counsel that a Notice of Abandonment had be mailed to Counsel's old address, for failure to respond to the outstanding Office Action. Examiner Nguyen informed counsel that, contrary to the Examiner's usual practice, Examiner did not attempt to telephone Counsel regarding the abandonment.

In response to Examiner's assertion that the Third Office Action Response was never received by the U.S. Patent and Trademark Office, Counsel undertook a search of Counsel's

files to attempt to locate the canceled check sent in with the Petition to Extend as part of the Third Office Action Response. Despite a diligent search, Counsel can find no record that Counsel's check number 2010 was ever cashed by the U.S. Patent and Trademark Office. On May 29th, 2003 Counsel called Examiner Nguyen to confirm the details laid out above, and informed Examiner Nguyen that Applicant never intended to abandon the application and that a petition to revive would be filed.

The Abandonment was Unavoidable

But for the failure to receive the Notice of Abandonment, or the customary phone call, the present Application would never have gone abandoned. Counsel mailed a response to the Outstanding Office Action in an envelope with the proper address and postage. Counsel put the latest and valid contact information on the Response, on the Response Transmittal, on the Petition to Extend, and included a USPTO Change of Address form indicating the new contact information. Counsel put in place mail forwarding from the old address to the new address, which has worked reliably and was in place when Examiner Nguyen asserts to have mailed the Notice of Abandonment. Counsel also put in place a telephone forwarding message indicating Counsel's new telephone number, the new telephone number having a reliable voice-mail service.

Counsel respectfully asserts that the abandonment of the present Application was unavoidable. Counsel has done everything in Counsel's power to keep the present application alive and put in place all of the procedures necessary to ensure prompt and reliable delivery of mail from the USPTO. This is demonstrated by the timely response to the outstanding Office Action, including Counsel's new contact information in the Response, to the mailing of a USPTO Change of Address form to the establishment of mail and phone forwarding. Counsel is the only person at Counsel's new address to check mail and reliably records every USPTO correspondence that is received. Had a Notice of Abandonment been received, or had the Examiner called Counsel, Counsel would have acted on such information to prevent the abandonment of the present Application.

A terminal disclaimer is not required as the present application was filed after June 8, 1995 as set forth in 37 C.F.R. §137(d)(a).

Included with this petition is a print out of the Response to Third Office Action originally mailed on September 11th, 2002, along with a signed Response to Third Office Action (identical except for the change in the date to reflect Counsel's signature on June 16th, 2003, and the properly dated and signed Certificate of Mailing by First Class Mail).

A petition fee of \$55.00 as specified under 37 C.F.R. §1.17(l) for a small entity is included in a check for \$255.00 attached to this petition (along with the fee of \$200.00 originally sent on September 11, 2002 for a two month extension to reply to the outstanding Office Action).

A swift decision on the merits is respectfully requested.

Respectfully submitted,

Dated: July 2, 2003

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